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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,088	01/18/2002	Graham John Hamilton Melrose	2354/141 (FF34527/02)	6479

7590 08/25/2005

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EXAMINER

KUMAR, PREETI

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,088

Applicant(s)

MELROSE ET AL.

Examiner

Preeti Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Final Rejection

1. Claims 1-13, 15-47 are pending.

Response to Amendment

2. The objection of claims 1-13, 15-47 is withdrawn in light of applicants amendment to the claims.
3. The rejection of claims 1-13, 15-43,45-47 under 35 U.S.C. 102(b) as being anticipated by Manoury et al. (US 4,711,892) is withdrawn upon further consideration of the prior art and applicants arguments. Specifically, Manoury et al. do not teach polymeric compounds.
4. The rejection of claims 1-13, 15-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of WO 00/03723 is withdrawn in light of applicants amendment to the claims.
5. The rejection of claims 1-9 and 11-23 and 43-47 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melrose et al. (WO 00/03723) is maintained for the reasons recited in the previous office action and further explained below. Examiner notes that claim 11 was previously inadvertently omitted and has been added to the list of claims rejected over Melrose et al., however, this does not constitute a new grounds of rejection as the material limitation of the claimed polyethylene glycol in claim 11 has been clearly addressed by the examiner in the previous office action dated 11/30/2004 (page 6, last paragraph) in the example 8 of the prior art teaching of WO 00/03723.

6. The rejection of claims 24-42 under 35 U.S.C. 103(a) as being unpatentable over Melrose et al. (WO 00/03723) is maintained for the reasons recited in the previous office action and further explained below.

New Grounds of Rejection

7. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments, see Remarks, filed 6/2/2005, with respect to claims 1-13 and 15-47 have been fully considered but are not found to be persuasive. Applicants urge that the composition of Melrose et al. (WO 00/03723) is distinctly different from the polymeric antimicrobial composition of claim 1 since Melrose et al. (WO 00/03723) makes no mention of forming a reaction product. Specifically applicants urge that, Melrose et al. teach a polymer that is dissolved in polyethylene glycol but there is no reaction product being formed. See applicants remarks pages 8-10.

Contrary to applicants arguments, examiner has shown that the prior art teaching of Melrose et al. (WO 00/03723) illustrates a composition comprising poly(2-propenal, 2-propenoic acid) in polyethylene glycol which is substantially identical to the material limitations of the instant claims. The language of the instant claims reciting that the derivative has protected carbonyl groups does not patentably distinguish the claims from the reference teaching a reaction with the exact same poly(2-propenal, 2-propenoic acid) and polyethylene glycol for 15 minutes at 70 degrees C. See example

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8 (a) page 19. Furthermore, said limitations are inherent to the invention of Melrose et al. (WO 00/03723) because Melrose et al. (WO 00/03723) illustrate by example the use of similar materials (i.e. poly(2-propenal, 2-propenoic acid)) and in the similar production steps (i.e. reaction with polyethylene glycol) to produce an antimicrobial composition. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. Applicants have not provided any support for the argument that the same components in the same composition would not result in the same property of the carbonyl groups being protected.

Furthermore, applicants have not provided any additional data or showing of unexpected or unobvious results to overcome the rejection of record.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YOGENDRA N. GUPTA
SUPERVISORY PATENT EXAMINER
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Preeti Kumar
Examiner
Art Unit 1751

PK